



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,397	04/19/2001	Leif Linde	64645-1049	9378

27045 7590 07/29/2004

ERICSSON INC.  
6300 LEGACY DRIVE  
M/S EVR C11  
PLANO, TX 75024

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/838,397

Applicant(s)

LINDE, LEIF

Examiner

John L Young

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/26/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3622

## **FIRST ACTION REJECTION**

**(Paper#7/26/2004)**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS — 35 U.S.C. §101**

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful  
process, machine, manufacture, or composition of matter or  
any new and useful improvement thereof, may obtain a  
patent therefore, subject to the conditions and requirements  
of this title.

2. Claims 1-9 & 17-23 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

Art Unit: 3622

As per independent claims 1 & 17, said claims are As per claim 1, as drafted said claim is not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999) within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05( q )).

Claims 2-8 & 18-23 are rejected for substantially the same reason as claim 1 & 17 respectively, because said claims depend from claims 1 & 17 or subsequent

Art Unit: 3622

base claims which depend from claims 1 & 17.

**CLAIM REJECTIONS — 35 U.S.C. §103( a )**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-23 are rejected under 35 U.S.C. §103( a ) as being obvious over Dedrick US 5,724,521 (03/03/1998) (herein referred to as "Dedrick").

As per claim 1, Dedrick (the col. 3, ll. 28-67) discloses the advertising system "*may be connected . . . as part of an overall wide area network (WAN). . . .*" In this instance the Examiner interprets a wide area network as suggesting the Internet.

Dedrick (col. 18, ll. 1-10) discloses the advertising system "*customize the contents*

Art Unit: 3622

*of the information for consumption by the individual end users. "*

Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18, ll. 34-64) shows: "A method for simulating the distribution of a promotion comprising the steps of: accessing target subscriber information for the promotion; selecting one or more subscribers to receive the promotion based on the target subscriber information and subscriber information associated with each subscriber; calculating one or more statistics regarding the selected subscribers; and providing the one or more statistics to a user."

Dedrick lacks an explicit recitation of "simulating the distribution of a promotion. . . .", even though Dedrick (col. 10, ll. 45-67) suggests same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18,

Art Unit: 3622

ll. 34-64) implicitly shows "simulating the distribution of a promotion. . . ." and it would have been obvious to modify and interpret the disclosure of Dedrick cited above as showing "simulating the distribution of a promotion. . . ." because modification and interpretation of the cited disclosure of Dedrick would have provided broad means for *"electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements. . . ."* (see Dedrick (col. 1, ll. 50-57)), based on the motivation to modify Dedrick so as to "[provide] electronic advertisements to end users in a consumer best-fit pricing manner. . . ." (See Dedrick (col. 1, ll. 60-65)).

As per claims 2-8, Dedrick shows the method of claim 1.

Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18, ll. 34-64) implicitly shows the elements and limitations of claims 2-8.

Dedrick lacks explicit recitation of the elements of claims 2-8, even though Dedrick implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Dedrick cited above implicitly shows the

Art Unit: 3622

elements and limitations of claims 2-8 and it would have been obvious to modify and interpret the disclosure of Dedrick cited above as showing the limitations of claims 2-8 because modification and interpretation of the cited disclosure of Dedrick would have provided broad means for *"electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements. . . ."* (see Dedrick (col. 1, ll. 50-57)), based on the motivation to modify Dedrick so as to "[provide] electronic advertisements to end users in a consumer best-fit pricing manner. . . ." (See Dedrick (col. 1, ll. 60-65)).

Independent claim 9 is rejected for the same reasons as independent claim 1.

Dependent claims 10-16 are rejected for the same reasons as dependent claims 2-8.

Independent claim 17 is rejected for substantially the same reasons as independent claim 1.

Dependent claims 18-21 are rejected for substantially the same reasons as dependent claims 10-13.

As per claim 22, Dedrick shows the system of claim 17.



Art Unit: 3622

Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18, ll. 34-64) implicitly shows the elements and limitations of claim 22.

Dedrick lacks explicit recitation of the elements of claim 22, even though Dedrick implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Dedrick cited above implicitly shows the elements and limitations of claims 22 and it would have been obvious to modify and interpret the disclosure of Dedrick cited above as showing the limitations of claims 22 because modification and interpretation of the cited disclosure of Dedrick would have provided broad means for *"electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements. . . ."* (see Dedrick (col. 1, ll. 50-57)), based on the motivation to modify Dedrick so as to "[provide] electronic advertisements to end users in a consumer best-fit pricing manner. . . ." (See Decrick (col. 1, ll. 60-65)).

Serial Number: 09/838,397 (Linde)

9

Art Unit: 3622

Dependent claim 23 is rejected for substantially the same reasons as dependent claim 15.

#### CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Serial Number: 09/838,397

(Linde)

10

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Patent Examiner

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

July 26, 2004